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10/788,543	02/27/2004	Stephen V. Deckers	10004377-4	7095

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EXAMINER

TRAN, KHOI H

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/788,543
Filing Date: February 27, 2004
Appellant(s): DECKERS, STEPHEN V.

Thomas Olson
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PO BOX 272400
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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/15/2005 appealing from the Office action mailed 05/18/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the Examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal US Patent Application Number 10/656,040.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,731,455	Kulakowski et al.	05-2004
5,329,412	Stefansky	07-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 24, 26-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski et al. 6,731,455 in view of Stefansky 5,329,412.

Kulakowski et al. '455 disclose a data storage library per claimed invention. The library comprises a plurality of storage areas for housing plurality of hard disk drive devices (HDD, see Figures 1A and 4). Each of the hard disk drive devices comprises a power supply (Figure 1A). The library comprises robotic grippers 62 for gripping and moving said HDD 's (Figures 2 and 3) from/to said storage areas. The library comprises a host device 72 (Figure 2) for controlling the library operations. The library comprises plurality of interfaces for communicatively linking or docking the HDD 's to the host device (Figures 2, 3, and 4). Kulakowski et al. '455 data storage library is also capable of handling tape cartridges or a combination of tape and hard disk drive devices

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(column 11, lines 21-47). However, Kulakowski et al. '455 are silent as to the specifics of the HDD having form factor in the shape of a tape cartridge.

Stefansky '412 discloses a portable hard disk drive device. Stefansky '412 teaches that the hard disk drive device housing can have the dimensions of a tape cartridge (column 1, lines 55-61).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimensions of Kulakowski et al. '455 HDD coincide with the housing dimensions of a magnetic tape cartridge, as taught by Stefansky '412, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Furthermore, it would have been obvious for one of ordinary skill in the art to have provided Kulakowski et al. '455 HDD with a housing having the same dimensions of a magnetic tape housing because such HDD cover had been known in the art, as demonstrated by Stefansky '412.

In regards to claims 24 and 31, Kulakowski et al. '455 disclose all elements per claimed invention as explained above. However it is silent as to the specifics of the HDD having form factor in the shape of a Digital Linear Tape (DLT).

It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimension of Kulakowski '455 HDD coincides with the housing dimension of a Digital Linear tape cartridge since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

(10) Response to Argument

It is noted that Appellant's intention is not to claim the "docking device" as part of the claimed combination (remarks filed on 12/27/2004). Therefore, the claimed phrase "adapted to...docking device" would not be given any patentable weight.

Appellant's arguments filed 09/15/2005 have been fully considered but they are not persuasive.

Appellant argued that the combination of Kulakowski et al. '455 and Stefansky '412 does not contain a "form factor" of a tape cartridge. Appellant insisted that the term "tape cartridge form factor" should be interpreted to have both "size and shape" of a tape cartridge. However, Appellant has failed to provide any details pointing out the specifics of a "tape cartridge form factor". The original specification is completely silent as to the specifics of a tape cartridge form. The exact shape of the claimed tape cartridge form is not known. The original specification is also completely silent as to the specifics of a tape cartridge dimension. The exact dimension of the claimed tape cartridge form is not known. The mere mentioning of "tape cartridge form factor" within the specification does not provide any structural distinctions as to exactly what the cartridge would resemble. In contrast to Appellant's argument, page 8, lines 2-6 of the specification indicates that the "tape cartridge form factor" could be in any shapes including the ones that are not known, **"it is understood, however, that the cartridge shell 111 need not adhere to a known cartridge form factor, and need not adhere to a tape cartridge form factor..."** Hence, based on a broad interpretation of "cartridge form factor", it is the Office's position that the combination of Kulakowski et al. '455 and

Stefansky '412 does provide a cartridge form factor per claimed invention, as explained above.

Appellant argued that Stefansky 's housing does not have a tape cartridge form factor, and thus, Stefansky does not have the teaching of providing a housing having a tape cartridge form factor. Nevertheless, Applicant concurred that Stefansky discloses "a single disk drive which... conforms to the dimension of a tape..." It is the Office's position that since the disk drive at least conforms to the dimension of a tape, it has a tape cartridge form factor.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, Stefansky '412 shows that portable hard disk drive device can be housed in a cover that has the dimensions and form factor of a tape cartridge. Thus, it would have been obvious for one of ordinary skill in the art to have provided Kulakowski et al. '455 HDD with a housing having the same dimensions of a magnetic tape housing because such HDD cover had been known in the art. In addition, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the housing dimensions of Kulakowski et al. '455 HDD

coincide with the housing dimensions of a magnetic tape cartridge, as taught by Stefansky '412.

Appellant's argued that there is no reasonable expectation of success in combining the references of Kulakowski et al. and Stefansky because the hard disk cartridges of the two references are different. Appellant argued that the "dual-ended" cartridge of Kulakowski could not be physically modified to be a "single-ended" cartridge, as taught by Stefansky '412. Applicant argued that in order to use the teaching in the secondary reference, one would have to bodily combine the "single-ended" data interface of the secondary reference into the primary reference. Essentially, these arguments are based on the feasibility of bodily incorporate the features in the secondary reference into the primary reference. These arguments are not persuasive. Appellant's attention is directed to the understanding that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, it is the combined teachings of providing a hard disk drive and a housing having the dimensions of a tape cartridge for a hard disk drive that provide the motivation to combine the secondary reference with the primary reference. Furthermore, please note that as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that

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the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (en banc), Cert. Deneid, 500 US 904 (1991) and In re Beattie, 974 F. 2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

(11) Evidence Appendix

No evidence is submitted in the Evidence Appendix.

(12) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Khoi H. Tran

Khoi H. Tran 10/25/05

Conferees:

Gene Crawford (SPE) *[Signature]*

Patrick Mackey (Primary Examiner) *[Signature]*